



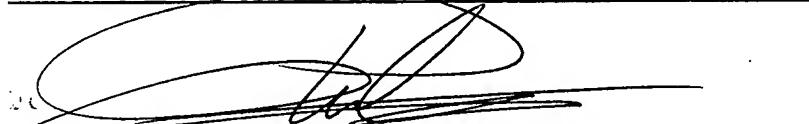
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carl F. Miles  
For : HEEL GUARD FOR USE WITH MOTORCYCLES  
Documents : Response to Office Action; Replacement drawing for Figure 16; and postcard.

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EU640896162US in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on January 9, 2005.

Richard C. Conover, Attorney for Applicant

  
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(Signature)

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January 9, 2005  
(Date)

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carl F. Miles  
Serial No. : 10/669,857  
Filed : 09/24/2003  
For : HEEL GUARD FOR USE WITH MOTORCYCLES  
Art Unit : 3611  
Examiner : Matt Luby

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE**

Dear Sir:

In response to the Office Action mailed October 6, 2004 for which a response is due on January 6, 2005, the applicant responds as follows:

The Examiner objected to Figure 16 because it was a color photograph. The applicant has now prepared a line drawing of Figure 16 and is submitting this new Figure with this Response. It is believed that with this submission, the objection to Figure 16 has been met.

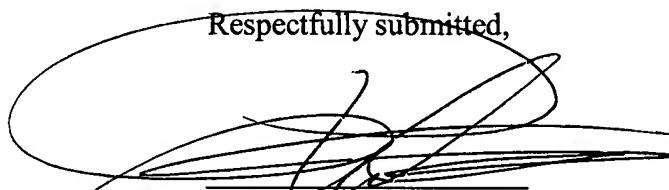
The Examiner rejected claims 1-7 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-7 of prior United States Patent No. 6,626,448. The applicant has submitted claims 1-7 in this application which were copies of claims 1-7 of the '448 patent' with the modification that the words "an operator" was changed to "a user". The reason for this change

was that the claim limitation of "operator" was believed to be unduly restrictive since the invention may also be used by a passenger carried behind the operator of the motorcycle. This is described in the specification on page 8, lines 16 through 21. It is believed that original claims 1-7 of the '448' could be interpreted as being restricted to the operator and not cover the use of this invention by a passenger. My client thought that the claims should be amended to cover both the operator and the passenger. For these reasons, it is believed that claims 1-7 of the present application are allowable as written because the claims 1-7 are not directed to the "same invention" as that set forth in claims 1-7 of the '448' patent.

In view of the foregoing, it is respectfully believed that the application is in condition for allowance.

DATED January 4, 2005  
Bozeman, Montana

Respectfully submitted,



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